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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/277,189	03/26/1999	EDWARD G. MCLAUGHLIN	048657-5001	3185

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EXAMINER

LINZEY, DAVID

ART UNIT

PAPER NUMBER

3628

DATE MAILED: 05/10/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/277,189

Applicant(s)

MCLAUGHLIN ET AL.

Examiner

David Linzey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 26 March 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. This application has been reviewed. Original claims 1 – 30 are pending.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 6 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 6 and 21 contain the trademark/trade name “Visa” and “Mastercard”. Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe networks and, accordingly, the identification/description is indefinite.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 1, 2, 5, 6, 9, 16, 17, 20, and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson U.S. Patent 5,978,780 in view of Cukor et al U.S. Patent 5,168,444.**

As per claims 1 and 16, Watson discloses a bill payment system having an account from which funds may be drawn, comprising the steps of:

(a) receiving at least one electronic bill for a customer (col. 1 lines 55 – 58); and

(d) presenting said at least one electronic bill and said extracted billing information

representative of said at least one paper bill to the customer (col. 2 lines 15 – 25).

Watson does not disclose scanning and viewing. Cukor does disclose a system which electronically presents documents comprising of (b) scanning at least one paper bill received for said customer to generate electronic image information (col. 10 lines 9 – 21), (c) extracting billing information from said electronic image information (col. 11 lines 34 – 49), and viewing an electronic image, which can be a bill (col. 10 lines 41 – 43). At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the scanning of Cukor to handle paper bills.

As per claims 2 and 17 Watson discloses

(e) receiving a payment instruction from a customer to pay a bill;

(f) drafting a payment on an account for the customer account; and

(g) sending the payment to the biller that originated the bill (col. 4 lines 55 – 65).

As per claim 5, Watson discloses the step of submitting an electronic payment (col. 2 lines 27 – 32).

As per claims 6 and 21, Watson discloses the step of submitting an electronic payment using one of an automated clearing house network, a automated teller machine network, a visa network, and a mastercard network (col. 3 lines 5 – 9).

As per claim 9, Watson discloses (c) presenting said extracted billing information representative of said at least one paper bill to the customer (Fig.3 - 322).

As per claim 20, Watson comprises a means for submitting an electronic payment (col. 1 lines 55 – 58).

4. Claims 3, 4, 7, 8, 10 – 15, 18, 19, and 22 - 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Watson in view of Cukor et al, and further in view of Abbruzzese et al U.S. Patent 5,557,515.

As per claims 3, 11, 18, and 26, Watson's disclosures are discussed above. Neither Watson nor Coker discloses physical checks being printed. Abbruzzese discloses the step of printing a physical check on said account (col. 59 lines 48 – 54). At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the check printing of Abbruzzese to pay those creditors who do not support electronic payments.

As per claim 7 and 22, neither Watson nor Coker discloses an optical scanner. Abbruzzese discloses the step of extracting billing information from said electronic image information using optical character recognition (col. 3 lines 37 - 44). At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill

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payment system of Watson to include the optical character recognition of Abbruzzese to scan billing information received by paper.

As per claims 8 and 23, neither Watson nor Coker discloses viewing electronic images of bills. Abbruzzese discloses the step of presenting an electronic image of a paper bill upon receipt of a request from the customer (col. 15 lines 6 – 8). At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the electronic images of Abbruzzese to view bills without using paper copies.

As per claims 10, 15, 25, and 30, neither Watson nor Coker discloses identifying and extracting from zones. Abbruzzese discloses a method comprising the steps of:

(1) identifying a type of bill based upon unique numeric identifiers contained within said paper bill; and

(2) extracting billing information from zones that are pre-defined for said type of bill (col. 81 lines 3 – 17).

At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the electronic imaging techniques of Abbruzzese to properly categorize bills within the database.

As per claims 4, 12, 19, and 27, Watson does not disclose the printing of remittance stubs. Cukor discloses printing scanned images from the database (col. 17 lines 17 – 39). Because the remittance stub would be scanned and stored in the database, the system in Coker would inherently include the printing of remittance stubs just as it prints checks.

As per claim 13, Watson discloses (d) receiving a payment instruction from a customer to pay said paper bill (col. 4 lines 55 – 65). Watson does not disclose scanning. Cukor does disclose a method comprising the steps of:

(a) scanning at least one paper bill received for said customer to generate electronic image information (col. 10 lines 9 – 21);

(b) extracting billing information from said electronic image information (col. 11 lines 34 – 49); and

(c) storing a scanned image of a remittance stub for said paper bill (col. 17 lines 17 – 39); presenting said extracted billing information representative of said paper bill to the customer.

Abbrezzese discloses;

printing a paper check on an account of the customer (col. 59 lines 48 – 54); and

(e) printing said stored scanned image of said remittance stub for said paper bill.

At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the scanning features of Cukor and the printing features of Abbruzzese to input and output information in paper form.

As per claims 14 and 29, Watson discloses a system that performs automatically (col. 1 lines 48 - 50).

As per claim 24, Watson is discussed above. Cukor discloses a means for scanning a paper bill received for a customer to generate electronic image information (col. 10 lines 9 – 21). Neither Watson nor Coker discloses the extraction of billing information. Abbezzese discloses a means for extracting billing information from said electronic image information using optical character recognition (col. 3 lines 37 - 44). At the time the system was made, it would have been

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obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the optical character recognition of Abbruzzese to scan billing information received by paper and the scanning of Cukor to handle paper bills.

As per claim 28, Watson, Cukor and Abbruzzese are discussed above. At the time the system was made, it would have been obvious to a person of ordinary skill in the art to modify the bill payment system of Watson to include the optical character recognition of Abbruzzese to scan billing information received by paper and the scanning of Cukor to handle paper bills, communicating with customers.

Conclusion

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Linzey whose telephone number is 703-305-4570. The examiner can normally be reached on M - F 8-5 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vincent Millen can be reached on 703-308-1065. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

DL
May 3, 2002

David Linzey
A.U. 3624